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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,800

03/24/2004

Jason Loke

KW03-001

6032

7590

05/26/2006

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EXAMINER

LAYNO, BENJAMIN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/808,800	LOKE, JASON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Benjamin H. Layno	3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Applicant's arguments filed 03/03/06 have been fully considered but they are not persuasive. The rejections follow.

#### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph "New Matter"***

2. Claims 6-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 6, lines 21-26 the recitations "if said first player cannot cast a word, said player must discard one card and forfeits turn to a next player to his/her left" and "said alphabet challenge card game continues until a player draws the last card from said draw pile and all cards are used up; said score keeper names a winner" contain subject matter which was **not** described in the specification at the time the application was filed.

3. The amendment filed 03/03/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the Amendments to the Specification, on lines 7-11 in the second paragraph (of the new paragraphs), the recitation "If the first player cannot cast a word, then the player must discard one card and forfeits his/her turn to a next player positioned to his/her left. The next player

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repeats the same word forming sequence. This process continues until a player draws the last card from the draw pile and all cards are used up.”

**Applicant is required to cancel the new matter in the reply to this Office Action.**

***Claim Rejections - 35 USC § 102 or § 103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 8, 9 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marcley et al.

The patent to Marcley discloses a method of playing a word forming card game. The game comprises a deck of 208 letter playing cards 10. Thus, there are at least seventy-two cards. 26 letters of the alphabet are repeated 8 times, col. 3, lines 15-18. Thus, there are at least four cards each of the letter S; three cards each of the letters B, C, D, F, M, P and T; at least two cards each of the letters G, H, L, N, R and W; one card each of the letters J, K, Q, V, X, Y and Z. Marcley's deck further includes two wild cards 50, col. 3, line 59. It is inherent or obvious that the wild cards may be used to substitute any letter of the alphabet. Marcley's deck further includes special function card designation 30.

To play Marcley's game each player is dealt a twelve card hand, col. 3, lines 55-56. The remaining cards are placed face down in a draw pile, removing a card from the draw pile, and placing the card face up to start a discard pile, col. 3, lines 60-65. Each play then attempts to form a word using his/her twelve cards and using the special function card 30, col. 4, lines 1-6. During each player's turn, each player draws a card from the draw or discard pile, col. 4, lines 18-21. It is inherent or obvious that if a player cannot form a word, the player forfeits his/her turn to the next player. The next player repeats the word forming sequence of forming a word and drawing a card from the draw or discard pile. The first player who completes a last formed word by drawing from the draw pile or discard pile is considered the winner, col. 4, lines 11-13.

In regard to claim 15, in Marcley's game, if the draw pile is used up before the game ends, it would be inherent or it would have been obvious to reshuffle all cards in the discard pile and place the cards face down to form a new deck and continue playing until one of the players win.

***Claim Rejections - 35 USC § 103***

7. Claims 7, 12, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcley et al. as applied to claim 6 above, and further in view of (Zeng and Scrabble)

The patent publication application to Zeng discloses a word forming card game teaches that it is known in word forming card games that use letter cards to form words, to form words similar to the game of Scrabble, paragraph [0170].

In regard to claims 12 and 13, in the game of Scrabble it is well known to use the "S" tile to convert a previously cast word by a current player to form a plural of the cast word. Furthermore in Scrabble, it is a well known rule for an opposing player to challenge a player that placed a word, requiring the player that placed the word to state the meaning of the word. In view of such teaching, it would have been obvious to use Marcley's cards to play a game of Scrabble. The rules of using the "S" card to form plural words, and the rule allowing players to challenge would have been used.

Concerning claim 7, Zeng teaches that it is well know to vary the number of decks used to play the game depending on the number of players playing. Example, "One deck of playing cards are used for two to four players, and two are used for five or

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six players", paragraph [0216]. In view of such teaching, it would have been obvious to use a varying number of decks in Marcley's game depending on the number of players playing. Determining exactly how many decks are used would have been a manufacturing design choice which is always obvious in the art.

In regard to claim 14, Zeng's word forming card game uses a point system, see Zeng's cards 22-27, Fig. 1. Point are awarded to a winner that forms a single word having the highest numerical rank or point value, paragraph [0210]. In view of such teaching, it would have been obvious to modify Marcley's cards by providing point values to each of Marcley's cards, similar to Scrabble. This modification would have made Marcley's playing cards adaptable to play different word forming games that use a point system like Scrabble.

In regard to claim 16, Marcley's game limits the word size to 3 letters, 4 letters and 5 letters. Determining exactly the limit to size of the words being formed would have simply been a manufacturing design choice which is always obvious in the art. It is also well known in word forming games to limit the words, such as Scrabble to define a word category to be used, in Scrabble words found in the dictionary are acceptable, while words that are abbreviations, prefixes, suffixes, that have hypens or an apostrophe are unacceptable. Thus, determining exactly what words are acceptable in Marcley's modified game above would have simply been a manufacturing design choice which is always obvious in the art.

***Allowable Subject Matter***

8. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph to claims 6-16, and objection under 35 U.S.C. 132(a) to the amendment filed 03/03/06, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. The Applicant has argued that Marclay et al. does not have a point system of merit and penalty points. Although, Zeng and Scrabble are directed towards remotely similar applications, it is respectfully suggested that the combination of these references cannot be made without reference to Applicant's own invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



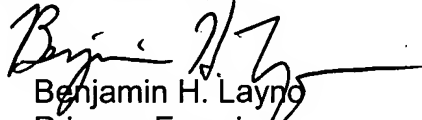
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl